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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/697,907	10/29/2003	Scott Malcolm Caplan	35006-556F01US	9741
76615 7590 05/26/2010 MINTZ, LEVIN, COHN, FERRIS, GLOVSKY AND POPEO, P.C ONE FINANCIAL CENTER BOSTON, MA 02111				
EXAMINER BOYCE, ANDRE D				
ART UNIT 3623		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/697,907

**Applicant(s)**

CAPLAN ET AL.

**Examiner**

Andre Boyce

**Art Unit**

3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 78-132 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 78-132 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Response to Amendment***

1. This Final office action is in response to Applicant's amendment filed 2/12/10.

Claims 1-77 are canceled, while claims 78-132 have been added.

2. The previously pending objection to the abstract has been withdrawn.

The previously pending objection to claim 43 has been withdrawn.

The previously pending rejection to claims 1-27 under 35 USC § 101 has been withdrawn.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 105 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection. See MPEP §2164.08(a).

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 78-131 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claims 78 and 105 recite "...each of said modules has the *capability* to interact...", which is rendered vague and indefinite, since having the "capability" does not necessarily indicate that the modules actually interact with an expert task manager. Clarification is required. Claims 2-27 and 29-54 are rejected based upon the same rationale as dependent claims.

Claims 90 and 117 are rendered vague and indefinite for use of the phrase "modeled crudely." It is unclear what constitutes a driver being modeled crudely by one or two decision keys.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 132 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim limitations "team development means for," "strategy situation analysis means for," "data request and reception means for," etc., use the phrase "means for" or "step for", but it is modified by some structure, material, or acts recited in the

claim. It is unclear whether the recited structure, material, or acts are sufficient for performing the claimed function which would preclude application of 35 U.S.C. 112, sixth paragraph, because the means for language is modified by sufficient structure.

If applicant wishes to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that the phrase "means for" or "step for" is clearly **not** modified by sufficient structure, material, or acts for performing the claimed function.

If applicant does **not** wish to have the claim limitation treated under 35 U.S.C. 112, sixth paragraph, applicant is required to amend the claim so that it will clearly not be a means (or step) plus function limitation (e.g., deleting the phrase "means for" or "step for").

### ***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 78-97, 99-124 and 126-132 are rejected under 35 U.S.C. 102(e) as being anticipated by Gronau et al (US 2003/0069869).

As per claim 78, Gronau et al disclose an iterative computer-implemented method for creating and evaluating strategies (i.e., development of a strategic plan through execution of a sequence of steps using a computer processor, ¶ 0014), comprising the steps of: providing a plurality of modules for the creation and evaluation of strategies (i.e., block diagram comprised of modules, figure 1), the modules comprising: a team development module for developing a strategy modeling team (i.e., resources 8, figure 1); a strategy situation analysis module for framing a decision situation (i.e., applying the computer aided strategic planning to preset rules and values to articulate a vision, develop goals in multiple domains and define objectives, ¶ 0020); a data request and reception module for designing and executing logistics of specifying, acquiring, and loading data required for decision and strategy modeling (i.e., profile builder 2, figure 2A); a data transformation and cleansing module for verifying, cleansing, and transforming data (i.e., rules, policies, axioms, values, priorities 3, figure 1); a decision key and intermediate variable creation module for computing additional variables from data and constructing a data dictionary (i.e., rules, policies, axioms, values, priorities 3, figure 1); a data exploration module for determining characteristics that are effective decision keys and intermediate variables (i.e., rules, policies, axioms, values, priorities 3, figure 1); a decision model structuring module for formalizing relationships between decisions, decision keys, intermediate variables, and value of a decision model (i.e., rules, policies, axioms, values, priorities 3, figure 1); a decision model quantification module for encoding information into a decision model (i.e., rules, policies, axioms,

values, priorities 3, figure 1); a strategy creation module for determining strategies that a client can test (i.e., goals 5, objectives 6 and action plans 7, figure 1); and a strategy testing module for testing strategies to guide refinement of strategies and refinement of a decision model and to select a best strategy for deployment (i.e., measurement and assessment 15, figure 1); wherein each of said modules has capability to interact with an expert task manager, wherein said expert task manager provides expert knowledge about strategy modeling processes and sub-processes (i.e., computer aided strategic planning expert system uses knowledge an difference procedures of an expert strategic planner, ¶ 0054), and executing the modules using at least one data processor forming part of a computer system (¶ 0014).

As per claim 79, Gronau et al disclose said strategy modeling team executing analysis to allow a leader of said strategy modeling team to convince a decision maker to implement a strategy favored by said analysis (i.e., resource enablers allowing strategy to move forward, figure 1).

As per claim 80, Gronau et al disclose identifying the values of the organization; and ensuring that the right decisions and strategies are considered in an analysis (i.e., applying the computer aided strategic planning to preset rules and values to articulate a vision, develop goals in multiple domains and define objectives, ¶ 0020).

As per claim 81, Gronau et al disclose designing and executing logistics of specifying, acquiring, and loading data required for decision and strategy modeling (i.e., data storage 18, figure 1).

As per claim 82, Gronau et al disclose verifying, cleansing, and transforming data (i.e., rules, policies, axioms, values, priorities 3, figure 1).

As per claim 83, Gronau et al disclose computing intermediate variables from said data, said intermediate variables dependent on decision keys; and constructing a data dictionary (i.e., rules, policies, axioms, values, priorities 3, figure 1).

As per claim 84, Gronau et al disclose providing insight into said data by determining which decision keys are most relevant for predicting said intermediate variables; and gaining insight into a customer's business and business processes (i.e., rules, policies, axioms, values, priorities 3, figure 1).

As per claim 85, Gronau et al disclose formalizing relationships between decisions, decision keys, intermediate variables, and value by connecting such in a model (i.e., rules, policies, axioms, values, priorities 3, figure 1).

As per claim 86, Gronau et al disclose encoding information into a decision model (i.e., rules, policies, axioms, values, priorities 3, figure 1).

As per claim 87, Gronau et al disclose applying optimization methods to a decision model to determine an optimal strategy for a set of cases (i.e., rules, policies, axioms, values, priorities 3, figure 1).

As per claim 88, Gronau et al disclose evolving using results from a decision model being enriched and from strategies tested (i.e., measurement and assessment 15, figure 1).



As per claim 89, Gronau et al disclose providing means for evaluating each strategy based on simulation; and providing means for evaluating a strategy in the field (i.e., measurement and assessment 15, figure 1).

As per claim 90, Gronau et al disclose beginning with a simplified value model having less than eight drivers (i.e., applying the computer aided strategic planning to preset rules and values to 1) articulate a vision, 2) develop goals in multiple domains, 3) define objectives, 4) selection of strategies, and 5) identification of action items, ¶ 0020); wherein each of said drivers is modeled crudely by one or two decision keys (i.e., preset rules and drivers); initially including no constraints; using said simplified value model for beginning said strategy creation module and said strategy testing module, said strategy creation module and said strategy testing module indicating areas of said decision model where refinement adds particular value; and after interaction between said decision model and strategies is acceptable, iteratively adding details reflecting limitations of a business process (i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020).

As per claim 91, Gronau et al disclose a team creation component and a decision quality component (i.e., resources 8 based on constraints and enablers, figure 1)

As per claim 92, Gronau et al disclose providing a decision quality process for enabling an organization to systematically identify, understand, and track views of quality of decision making (i.e., computer aided strategic planning expert system

uses knowledge and inference procedures to assist the user, including monitoring, control and instruction, ¶¶ 0054-0063).

As per claim 93, Gronau et al disclose providing any of six dimensions associated with any of six links in a decision quality chain, said any of six links comprising: appropriate frame; creative-feasible alternatives; meaningful-reliable information; clear values and tradeoffs; logically-correct reasoning; and commitment to action (i.e., development of action plan, ¶ 0069); wherein said chain supports an organization's value (i.e., definition of values applied to the planning, ¶ 0068).

As per claim 94, Gronau et al disclose framing a problem by: identifying issues; developing a decision hierarchy; understanding an organization's values; and brainstorming and clarifying alternatives (i.e., development of a profile to define values, priorities, policies and rules, ¶ 0068); further understanding said organization's values by: developing value metrics and prototyping metric results (i.e., development of a profile to define values, priorities, policies and rules, which are added to the factory established rules and axioms, ¶ 0068); and planning for data acquisition by: identifying intermediate variables; and developing a plan for assessment (i.e., diagnosis and prescription, ¶¶ 0054-63); wherein for clarification: optionally returning to said framing a problem step after said further understanding said organization's values step; and optionally returning to said further understanding said organization's values step after said planning for data acquisition step (i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020).

As per claim 95, Gronau et al disclose developing data parameters, including: determining data elements; designing a performance period; determining data records; and constructing an initial data dictionary; determining transfer parameters, including: determining transfer format; and determining transfer method; preparing data, including: assembling transfer data; and transferring data; and loading data on a target system (i.e., embedded tools (16) resident in the program that include calculators, accessories, planners, questionnaires and links both to external tools (22) for export/import of data and to the internet for available information, ¶ 0070).

As per claim 96, Gronau et al disclose validating original data sets, comprising: investigating original data sets; and cleaning original data sets; creating analysis data sets, comprising; and transforming data; and computing additional variables; validating analysis data sets, comprising; transforming data; and computing additional variables; wherein while creating analysis data sets and problems are uncovered in original data sets, then original data sets are further cleaned and retransformed; and wherein while validating analysis data sets and problems in said transformation, or in original data sets, are uncovered, then such tasks are revisited (i.e., rules, policies, axioms, values, priorities 3 applied to data, figure 1).

As per claim 97, Gronau et al disclose first creating dependent variables useful for decision models, comprising: identifying concepts; triaging concepts; and defining dependent variables; and creating independent variables useful for decision models, comprising identifying concepts; triaging concepts; and defining dependent variables; wherein intermediate variables depend on decision keys, other

intermediate variables, or decisions; and wherein each intermediate variable encapsulates a predictive model with a dependent variable and independent variables (i.e., rules, policies, axioms, values, priorities 3 applied to data, figure 1).

As per claim 99, Gronau et al disclose conceptualizing by selecting intermediate variables that drive value; building coarse models of intermediate variables; and verifying constraints; and drawing a decision model structure; wherein said conceptualizing is iteratively available for use after said drawing (i.e., rules, policies, axioms, values, priorities 3 applied to data, figure 1).

As per claim 100, Gronau et al disclose modeling intermediate variables; filling in nodes with models, functions, and/or constants; and validating said decision model; wherein said modeling step is iteratively available from said filling in step, and wherein said filling in step is iteratively available from said validating said decision model step (i.e., rules, policies, axioms, values, priorities 3 applied to data, figure 1).

As per claim 101, Gronau et al disclose the step of providing a score tuner component for automating decision model updating and reporting (i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020, including measurement and assessment and reports generation, ¶¶ 0030-31), said score tuner component comprising any of: data awareness capability; triggering rules (i.e., preset rules and values); model history retention; self-guided model development; connection to a decision engine; and execution and analytic audit trails; wherein when a tuning run is triggered, results are reviewed and either accepted and an update is deployed, or rejected

(i.e., as new information is entered, the computer aided strategic planning program automatically updates the plan across domains, ¶ 0020, based upon the preset rules and axioms).

As per claim 102, Gronau et al disclose performing model optimization, comprising: identifying metric variables; determining optimization parameters; and running optimization; analyzing optimization results, comprising viewing optimization results; and performing sensitivity analysis on constraints; and developing strategies, comprising: building strategies; and refining strategies; wherein the performing model optimization step and the analyzing optimization results step are available to be used iteratively from either the analyzing optimization results step or the developing strategies step (i.e., measurement and assessment 15, figure 1).

As per claim 103, Gronau et al disclose providing a non-linear constrained optimization tool for improving test designs and optimizing strategies (i.e., computer aided strategic planning program, ¶ 0020).

As per claim 104, Gronau et al disclose testing strategies, comprising: performing strategy simulation; and performing field testing; evaluating strategies; and performing active data collection; wherein said testing strategies step is available for being used iteratively from said evaluating strategies step (i.e., measurement and assessment 15, figure 1).

Claims 105-124 and 126-131 are rejected based upon the same rationale as the rejections of claims 78-97 and 99-104, respectively, since they are the apparatus claims corresponding to the method claims.

Claim 132 is rejected based upon the same rationale as the rejection of claim 1, since it is the system claim corresponding to the method claim.

***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 98 and 125 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gronau et al (US 2003/0069869), in view of Zagotta et al (US 2002/0147626).

As per claim 98, Gronau et al does not disclose applying basic statistical analysis, comprising: analyzing continuous variables; and analyzing discrete variables; applying variable reduction techniques, comprising: applying human and business judgment; and applying computational methods; applying advanced statistical analysis; verifying results; and presenting said results. Zagotta et al disclose key measures 455 including facts and statistics related to the data and strategy (§ 0056). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include applying basic statistical analysis in Gronau et al, as seen in Zagotta et al, since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Claim 125 is rejected based upon the same rationale as the rejection of claim 98, since it is the apparatus claim corresponding to the method claim.

### ***Response to Arguments***

13. In the Remarks, Applicant argues Gronau does not disclose a system for creating and evaluating strategies as recited in the current claims. The Examiner respectfully disagrees and submits Gronau et al and Zagotta et al disclose the claim limitations, as seen in the rejection above.

### ***Conclusion***

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andre Boyce whose telephone number is (571)272-6726. The examiner can normally be reached on 9:30-6pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andre Boyce/  
Primary Examiner, Art Unit 3623  
May 23, 2010